

Notice of Allowability

Application No.

09/997,514

Examiner

Fozia M. Hamud

Applicant(s)

DESNOYERS ET AL.

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 12/30/2004.
2. ☒ The allowed claim(s) is/are 119-127 and 129-131, (now renumbered 1-12, respectively).
3. ☒ The drawings filed on 15 November 2001 are accepted by the Examiner.
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☒ Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No./Mail Date 12/30/04; 05/31/02
4. ☐ Examiner's Comment Regarding Requirement for Deposit
of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☐ Interview Summary (PTO-413),
Paper No./Mail Date _____
7. ☐ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____


JANET ANDRES
PRIMARY EXAMINER

HL

REASONS FOR ALLOWANCE:

1. Applicants' arguments and amendment amending claims 119-127, 130, and canceling claim 128, filed on 30 December 2004 is acknowledged.

Thus claims 119-127 and 129-131 are pending and are in condition for allowance.

Correction of Inventorship under 37 C.F.R. 51.48(b)

2. Applicants' request for correction of inventorship under 37C.F.R. 9 1.48 (b) filed on 25 January 2005, is granted

Priority:

3. Applicants submit that they rely on the chondrocyte redifferentiation assay for patentable utility of this case, which was first disclosed in International Application PCT/US/00/08439, filed March 30, 2000, priority for which has been claimed in this application. Upon examining the PCT/US/00/08439, filed March 30, 2000, (WO200073454) it is found that this assay is disclosed in this application, (see SEQ ID NO:422, and page 531).

Therefore, the present application is afforded an effective filing date of March 30, 2000.

Withdrawal of previous Rejections:

4a. The rejection of claims 119-131 made under U.S.C. § 102 (b) as being anticipated by Ashkenazi et al (WO200032221; published 08 June 2000) is withdrawn, because the effective filing date (30 March 2000) of the current application predates the publication of this reference. Similarly, the rejection of claims 119-125, 130 made under U.S.C. § 102 (b) as being anticipated by

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Walker et al (WO200029574; published 25 May 2000), is withdrawn, because the effective filing date of the current application predates the publication of this reference.

4b. Regarding the rejection of claims 119-131 made under U.S.C. § 102 (b) as being anticipated by Baker et al (WO9963088; published 09 December 1999), the instant application claims priority to U.S Provisional Application 60/097978 filed on 26 August 1998, which discloses as much as the WO9963088 reference. Accordingly, it appears that the WO9963088 reference is not prior art, since the filing of Applicants' provisional application 60/097978 filed on 26 August 1998 predates the publication of this reference.

Therefore, 119-127 and 129-131 are free of prior art of record.

5a. The rejection of claims 119-124, 127-128 and 130-131 made under 35 U.S.C. 112, first paragraph, for not enabling the full scope of the claims and for lacking written description is withdrawn, because the claims recite both structural and functional limitations. Furthermore, one skilled in the art can make and use the claims.

5b. The rejection of claims 119-124 and 128-131 made under 35 U.S.C. 112, second paragraph, is withdrawn, because the amended claims are no longer recite the vague limitations.

Conclusion:

6. Claims 119-127 and 129-131 are free of prior art of record and are allowed.

Advisory Information:

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fozia M. Hamud whose telephone number is (571) 272-0884. The examiner can normally be reached on Monday, Thursday-Friday, 6:00 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brenda G. Brumback can be reached on (571) 272-0961. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Fozia Hamud
Patent Examiner
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17 March 2005